

# Notice of Allowability

## Application No.

09/591,466

## Examiner

Jeanine A Goldberg

## Applicant(s)

SCHAEWEN, ANTJE VON

## Art Unit

1634

### -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 2/18/03.
2. ☒ The allowed claim(s) is/are 36,38,40 and 48.
3. ☒ The drawings filed on 09 June 2000 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All b) ☐ Some\* c) ☐ None of the:
    1. ☒ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
  - \* Certified copies not received: \_\_\_\_\_.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No. \_\_\_\_\_.
  - (b) ☐ including changes required by the proposed drawing correction filed \_\_\_\_\_, which has been approved by the Examiner.
  - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the top margin (not the back) of each sheet. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## Attachment(s)

- |  |  |
|--|--|
| 1 <input type="checkbox"/> Notice of References Cited (PTO-892)  | 2 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)               |
| 3 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                    | 4 <input checked="" type="checkbox"/> Interview Summary (PTO-413), Paper No. <u>0403</u> |
| 5 <input type="checkbox"/> Information Disclosure Statements (PTO-1449), Paper No. _____               | 6 <input checked="" type="checkbox"/> Examiner's Amendment/Comment                       |
| 7 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8 <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance      |
|  | 9 <input type="checkbox"/> Other   |

### **DETAILED ACTION**

1. This action is in response to the papers filed February 18, 2003. Claims 2-3, 31-35, 37, 39, 47 were cancelled without prejudice or disclaimer.
2. Claims 36, 38, 40, 48 are allowable as amended below.

### **EXAMINER'S AMENDMENT**

3. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.
4. Authorization for this examiner's amendment was given in a telephone interview with Ping Hwung on April 10, 2003.
5. The application has been amended as follows:
  - A) Claim 36 has been amended to recite - - An isolated nucleic acid which encodes a polypeptide having N-acetyl glucosaminyl transferase I activity and is selected from the group consisting of:
    - a) a nucleic acid comprising SEQ ID NO: 1;
    - b) a DNA sequence encoding the amino acid sequence of SEQ ID NO: 2;
    - c) and complements thereof. - -
  - B) Claim 38 has been amended to deleted "construct" and replace therefore - - vector - -
  - C) Claim 48 been amended to deleted "construct" and replace therefore - - vector - -
  - D) Claims 49-52 have been cancelled without prejudice or disclaimer.

6. The following is an examiner's statement of reasons for allowance.

The elected claims are drawn to an isolated nucleic acid encoding a polypeptide having N-acetyl glucosaminyl transferase I activity. SEQ ID NO: 1 and nucleic acids encoding SEQ ID NO: 2 are directed to *Solanum tuberosum* nucleic acids.

The closest prior art teaches a human nucleic acid which encodes a polypeptide having N-acetyl glucosaminyl transferase I activity. This sequence does not fall within the scope of the claims because, the instant potato nucleic acid is 59% identical with the human N-acetyl glucosaminyl transferase I. Moreover, the mouse, rat and round worm are not encompassed by the claims (see Figure 3A).

The art does not teach nor suggest SEQ ID NO: 1 or nucleic acids encoding SEQ ID NO: 2.


7. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jeanine Goldberg whose telephone number is (703) 306-5817. The examiner can normally be reached Monday-Friday from 8:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (703) 308-1152. The fax number for this Group is (703) 305- 3014.

Any inquiry of a general nature should be directed to the Group receptionist whose telephone number is (703) 308-0196.

  
Jeanine Goldberg  
April 10, 2003

  
W. Gary Jones  
Supervisory Patent Examiner  
Technology Center 1600